UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,745	02/12/2004	Gregory A. Griffin	D5260	5613

30409 7590 06/22/2007

INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY
4201 WINFIELD ROAD
P.O. BOX 1488
WARRENVILLE, IL 60555

EXAMINER	
PATEL, VISHAL A	
ART UNIT	**PAPER NUMBER**
3673	

MAIL DATE	DELIVERY MODE
06/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/777,745
Filing Date: February 12, 2004
Appellant(s): GRIFFIN ET AL.

Griffin et. al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/25/07 appealing from the Office action mailed 8/22/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,553,644	Schenk	4-2003
3,811,689	Farnam	5-1974
4,819,954	Fucci et al	4-1989
5,618,047	Belter	4-1997

6,543,787	Inciong	4-2003
4,091,141	Harris	5-1978

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Unclear how a gasket can have a fastener, since a gasket assembly can have a fastener but not a gasket. Attention should be given to what applicant has originally claimed just a gasket.

Claim Rejections - 35 USC § 103

2. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk (US. 6,553,664) in view of Farnam (US. 3,811,689) and further in view of Fucci et al (US. 4,819,954).

Schenk discloses a gasket having a metal substrate (substrate having 18a-18b) disposed along an outer perimeter of the gasket, an elastomeric bead (bead having 68, see figure 8) disposed along at least a part of an interior of the metal substrate, the metal substrate having a fastener openings (plurality of openings 60) having an inner diameter (inner diameter of 60), a fastener capable of being disposed in the openings (as stated in the reference that 60 are bolt holes that will receive fasteners), fasteners having an outer diameter (outer diameter of a potential fastener), a plurality of teeth (teeth that are shown in figure 1) disposed along an outer perimeter of the elastomeric bead correspond with a plurality of grooves (grooves on inner

perimeter as shown in figure 2) disposed along at least a section of the interior perimeter of the metal substrate, the elastomeric bead is also placed on an outer perimeter of the gasket in a manner same as the elastomeric bead placed on the inner perimeter of the gasket (figures 8-9 and column 6) and the gasket is capable of fitting a flange having a fastener hole (this would be the case since the gasket of Schenk is capable of being used between two flange surfaces). The gasket is capable of being used in a manner as claimed by applicant in claims 6-7, 10-11. The gasket having a depression in the metal substrate (depression having a sealing bead).

Schenk discloses the invention substantially as claimed above but fails to disclose that each of the fastener openings having an elastomeric ring. Farnam teaches that a gasket having fastener openings and each fastener opening having an elastomeric ring on an inner diameter of the fastener opening (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure each of the fastener opening of Schenk to have an elastomeric ring as taught by Farnam to provide a seal around fasteners when the fasteners are installed through the elastomeric rings (column 2, lines 30-36 or lines 45-56).

Schenk and Farnam disclose the invention substantially as claimed above but fail to disclose that an inner diameter of the elastomeric ring being smaller than an outer diameter of the fastener. Fucci et al discloses an elastomeric ring or plastic ring around a fastener opening in a gasket, the elastomeric ring having an inner diameter smaller than an outer diameter of the fastener (see figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner diameter of Schenk and Farnam to be smaller than an outer diameter of the fastener as taught by Fucci, to provide a subassembly by the fastener components (column 3, lines 60-66 of Fucci).

3. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belter (US. 5,618,047) in view of Farnam and in further view of Fucci.

Belter discloses a gasket having a metal substrate disposed along an outer perimeter of the gasket, an elastomeric bead disposed along an interior perimeter of the metal substrate and a plurality of teeth (44) disposed along an outer perimeter of the elastomeric bead corresponding with a plurality of groove (figure 6) disposed along at least a section of the interior perimeter of the metal substrate. A fastener receivable in openings 48. The openings having an inner diameter.

With regard to the ring having the inner diameter smaller than an outer diameter of a fastener. Applicant has not positively claimed the fastener and therefore the limitation is not given patentable weight.

The limitation that the elastomer is injection molded is given little patentable weight because this is a process limitation within a product claim. The gasket comprising a depression formed in the metal substrate (depression having 42 or wavy depression having 42).

Belter discloses substantially the same seal as applicant except for an elastomeric ring disposed along fastener holes on the metal substrate. Farnam discloses an elastomeric ring (24) disposed along fastener holes (holes in sheet gasket that holds a fastener) that hold fastener along a substrate in order to provide sealing around a fastener. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Belter gasket to have an elastomeric ring that has fastener as taught by Farnam in order to provide sealing around a fastener and retain a fastener before attachment of the gasket to a member (column 2, lines 30-

36 or lines 45-56). Furthermore Farnam also teaches to select a material for the bushing by a matter of environmental use (depends on compression force or thermal load or etc).

Belter and Farnam disclose the invention substantially as claimed above but fail to disclose that an inner diameter of the elastomeric ring being smaller than an outer diameter of the fastener. Fucci et al discloses an elastomeric ring or plastic ring around a fastener opening in a gasket, the elastomeric ring having an inner diameter smaller than an outer diameter of the fastener (see figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner diameter of Belter and Farnam to be smaller than an outer diameter of the fastener as taught by Fucci, to provide a subassembly by the fastener components (column 3, lines 60-66 of Fucci).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk, Farnam and Fucci as applied to claims above, and further in view of Inciong (Us. 6,543,787).

Schenk, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the elastomeric bead and the elastomeric are form as a continuous rubber material. Inciong discloses that a gasket having an elastomeric ring and an elastomeric bead disposed around a metal substrate to be formed as a continuous member (see figures). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the elastomeric ring and the elastomeric bead of Schenk, Farnam and Fucci to be formed as a single piece as taught by Inciong to reduce cost (this would be the case since both the elastomeric bead and the elastomeric ring would be formed in a single molding process).

5. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belter, Farnam and Fucci as applied to claims above, and further in view of Nenzell (US. 2,795,444).

Belter, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the first and second elastomeric rings on fastener openings are connected to the inner diameter of the fastener openings by plurality of teeth placed in plurality of grooves formed on the inner diameter of the fastener openings. Nenzell discloses a fastener opening in a substrate and a rubber member attached to an inner diameter of the opening by plurality of teeth received in grooves in the inner diameter of the opening (see figures 1-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the inner diameter of the fastener openings and the elastomeric rings of Belter, Farnam and Fucci to have grooves and teethes, respectively as taught by Nenzell, to provide a proper connection or strong connection between the inner diameter of the fastener openings and the elastomeric rings (see column 3, lines 1-6 of Nenzell).

6. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk, Farnam and Fucci as applied to claims above, and further in view of Nenzell (US. 2,795,444).

Schenk, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the first and second elastomeric rings on fastener openings are connected to the inner diameter of the fastener openings by plurality of teeth placed in plurality of grooves formed on the inner diameter of the fastener openings. Nenzell discloses a fastener opening in a substrate and a rubber member attached to an inner diameter of the opening by plurality of teeth received in grooves in the inner diameter of the opening (see figures 1-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the inner diameter of the fastener openings and the elastomeric rings of Schenk, Farnam and Fucci to have grooves and teethes, respectively as taught by Nenzell, to provide a proper

connection or strong connection between the inner diameter of the fastener openings and the elastomeric rings (see column 3, lines 1-6 of Nenzell).

(10) Response to Argument

Appellants' arguments filed 1/25/07 have been fully considered but they are not persuasive.

Answer to arguments that claims 1-4 and 6-7, are rejected under 112 second paragraph:

Appellants' argument that claims 1-4 and 6-7 are improperly rejected under 112 second paragraph is not persuasive because as stated in the rejection claim 1 claims a fastener. A gasket assembly can have a fastener but not a gasket as claimed in line 1 by appellant. Furthermore as shown in figures 3-6, a gasket does not have a fastener but a gasket assembly as shown in figures 1-2 has a fastener 205. In conclusion it is unclear if applicant is trying to claim a gasket, which is a sub-combination or a gasket assembly, which is a combination. As stated in the rejection above the examination is based on a gasket and not a gasket assembly.

Appellants' argument that claim 8 is rejection under 112 second paragraph is not persuasive because claim 8 is not rejected under 112 second paragraph. In conclusion applicant has claim only a gasket and the limitations directed to a fastener is recited as functional use or intended use limitations.

Answer to arguments to claims 1-3 and 6-12, rejected by Schenk, Farnam and Fucci:

Appellants' argument that the ring deforms plastically for the invention taught by Schenk, Farnam and Fucci is not persuasive because the appellants do not claim this.

Appellants' argument that neither Schenk, Farnam and/or Fucci alone or in combination teach an elastomeric ring...opening is not persuasive because Farnam teaches this. Farnam states

in column 3, line 60 to column 4, line 3, "Among these are phenolic filled asbestos millboard laminates, phenolic filled asbestos paper board laminates, solid molded plastic and metallic insert members". One skilled in the art realizes that Farnam has taught all degree of elastomeric material to rigid material, phenolic filled asbestos is considered to be an elastomeric material and metal inserts is considered to be rigid material. Evidence is shown by Harris (4,091,141) that phenolic filled asbestos is considered to be an elastomeric material (column 6, lines 1-6).

Appellants' argument that the reference of Schenk, Farnam and Fucci do not establish a prima facie case of obviousness is not persuasive because as stated in the rejection Schenk teaches all the limitation except an elastomeric ring around an opening but Farnam teaches to provide a seal around fasteners when the fasteners are installed through the elastomeric rings (column 2, lines 30-36 or lines 45-56 of Farnam) and Fucci teaches that the ring to be smaller than an outer diameter of a fastener to provide a subassembly by the fastener components (column 3, lines 60-66 of Fucci).

Appellants' argument that Farnam teaches that the rings or inserts are formed of high strength material is correct but theses high strength material are capable of being elastomeric (column 3, line 60 to column 4, line 3 of Farnam).

Appellants' argument that the resulting combination of Farnam and Fucci will yield a device that will not operate to elastically deform rings is not persuasive because this is not what applicant claims.

Appellants' argument that neither Schenk, Farnam and/or Fucci teach that the inner diameter is smaller than an outer diameter of a fastener is not persuasive because Fucci teaches this and clearly shown this in figure 4.

Appellants' argument that the combination of Schenk, Farnam and Fucci do not teach all the claims limitations is not persuasive in view of the rejection above.

Answer to arguments to claims 1-3 and 6-12, rejected by Belter, Farnam and Fucci:

Appellants' argument that neither Belter, Farnam and/or Fucci alone or in combination teach an elastomeric ring...opening is not persuasive because this is taught by Farnam. Farnam states in column 3, line 60 to column 4, line 3, "Among these are phenolic filled asbestos millboard laminates, phenolic filled asbestos paper board laminates, solid molded plastic and metallic insert members". One skilled in the art realizes that Farnam has taught all degree of elastomeric material to rigid material, phenolic filled asbestos is considered to be an elastomeric material and metal inserts is considered to be rigid material. Evidence is shown by Harris (4,091,141) that phenolic filled asbestos is considered to be an elastomeric material (column 6, lines 1-6).

Appellants' argument to piecemeal is not persuasive because the rejection based on Belter, Farnam and Fucci is as best as rejection base on Schenk, Farnam and Fucci. Furthermore the reason for dual rejection is that claim 4 is rejected by Schenk, Farnam, Fucci and Inciong.

Appellants' argument that neither Belter, Farnam and/or Fucci teach that the inner diameter is smaller than an outer diameter of a fastener is not persuasive because Fucci teaches this and clearly shown this in figure 4.

Answer to arguments to claim 4, rejected by Schenk, Farnam, Fucci and Inciong:

Appellants' argument that neither Schenk, Farnam and/or Fucci teach the elastomeric bead and the elastomeric ring are formed of a continuous rubber material that is formed on the metal substrate is correct but this is taught by Inciong.

Appellants' argument that Inciong fails to teach a fastener that is disposable within the opening and radially compressing of the elastomeric ring between the fastener and the opening when the fastener is inserted in the elastomeric ring is not persuasive because this is considered to be intended use limitation and/or method limitation. Furthermore Inciong teaches to have a hole 20 that is capable of receiving a fastener.

In response to appellant's argument that claim 1, lines 11-13, "when...the opening.", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to Appellant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Answer to arguments to claims 13-20, rejected by Schenk, Farnam, Fucci and Nenzell:

Appellants' argument that neither Schenk, Farnam and/or Fucci alone or in combination teach an elastomeric ring...opening is not persuasive because this is taught by Farnam. Farnam states in column 3, line 60 to column 4, line 3, "Among these are phenolic filled asbestos millboard laminates, phenolic filled asbestos paper board laminates, solid molded plastic and metallic insert members". One skilled in the art realizes that Farnam has taught all degree of elastomeric material to rigid material, phenolic filled asbestos is considered to be an elastomeric material and metal inserts is considered to be rigid material. Evidence is shown by Harris

(4,091,141) that phenolic filled asbestos is considered to be an elastomeric material (column 6, lines 1-6).

Appellants' argument that neither Schenk, Farnam and/or Fucci teach that the inner diameter is smaller than an outer diameter of a fastener is not persuasive because this is taught by Fucci (figure 4 of Fucci).

Answer to arguments to claims 13-20, rejected by Belter, Farnam, Fucci and Nenzell:

Appellants' argument that neither Belter, Farnam and/or Fucci alone or in combination teach an elastomeric ring...opening is not persuasive because this is taught by Farnam. Farnam states in column 3, line 60 to column 4, line 3, "Among these are phenolic filled asbestos millboard laminates, phenolic filled asbestos paper board laminates, solid molded plastic and metallic insert members". One skilled in the art realizes that Farnam has taught all degree of elastomeric material to rigid material, phenolic filled asbestos is considered to be an elastomeric material and metal inserts is considered to be rigid material. Evidence is shown by Harris (4,091,141) that phenolic filled asbestos is considered to be an elastomeric material (column 6, lines 1-6).

Appellants' argument to piecemeal is not persuasive because the rejection based on Belter, Farnam and Fucci is as best as rejection base on Schenk, Farnam and Fucci. Furthermore the reason for dual rejection is that claim 4 is rejected by Schenk, Farnam, Fucci and Inciong.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Vishal Patel

VISHAL PATEL
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Conferees:

Vishal Patel,

Patricia Engle,

Meredith Petravick,